

Remarks:

Claims 1-20 are pending in the current application. Claims 1-3, 5-14, 15-18, and 20 were rejected under 35 U.S.C. §102, and claims 4, 15, and 19 were rejected under 35 U.S.C. §103. In response, Applicant has amended claims 1, 3-6, 8, 11, and 13-19. Claims 2, 10, 12, and 20 have been canceled. No new matter has been added. Support for the amended language is provided in the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

§102 Rejection(s):

Claims 1-3, 5-14, 15-18, and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application No. 2002/0194331 to Lewis et al. (hereafter *Lewis*). This ground of rejection is respectfully traversed.

Anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131. Since *Lewis* fails to disclose at least one of the recited elements in amended claim 1, a rejection under §102 would be improper.

Lewis discloses a method and corresponding system for notifying a mobile station, which is fully engaged in an existing call, of another incoming call. See *Lewis*, paragraph [0008]. That is, *Lewis* teaches detecting a request to establish a voice call with a mobile station and then determining the call state of the mobile station. If the mobile station is fully engaged such that the mobile station cannot accept the incoming call without disconnecting from an existing call, an incoming call notification is transmitted to the mobile station. See *Lewis*, paragraphs [0010], [0031]. The incoming call may also be routed to a home mobile switching center, and the home mobile switching center may play an announcement to the incoming caller. See *Lewis*, paragraph [0061].

As such, *Lewis* fails to disclose “determining whether the first data belongs to one or more predetermined categories of data to be forwarded to the general-purpose computer; generating second data from the first data, in response to determining that the second data is needed to cause the general-purpose computer to execute one or more second telephony events equivalent or similar to the one or more first telephony events; and forwarding the first data or second data to the general-purpose computer, without regard to the call state of the mobile device, in response to determining that the first data belongs to the one or more predetermined categories, wherein the general-purpose receives the first or second data and executes the one or more second telephony events, allowing a user to access or respond to the one or more second telephony events using additional resources not available on the mobile device,” as recited in claim 1.

The Examiner contends that playing an announcement for an incoming caller, as disclosed in *Lewis*, is analogous to the second telephony events recited in claim 1. See Office Action, page 3. Applicant respectfully disagrees. The second telephony events recited in claim 1 are “equivalent or similar” to the first telephony events with the only difference being that the first telephony events are executed on a mobile device, while the second telephony events are executed on a general-purpose computer. *Lewis* discloses playing an announcement for an incoming call, in response an incoming call received by the mobile station. Respectfully, receiving an incoming call and announcing the incoming call are not “equivalent or similar” events, as recited in claim 1, as amended.

Additionally, the call announcement in *Lewis* is generated using a home mobile switching center and does not provide a user to access or respond to the incoming call, in the same manner as claimed in claim 1, wherein a general-purpose computer provides a user with “additional resources” to access or respond to a telephony event received on the mobile device, wherein such additional resources are not available on the mobile device.

Applicant has reviewed the cited reference and is unable to find any portion of the cited reference that teaches or suggests the above-noted elements of claim 1. Therefore, the Applicant

respectfully requests that the Examiner withdraw the §102 ground of rejection or point out the portions of the cited reference that suggest all such elements with specificity.

Furthermore, *Lewis* directly teaches away from the claimed invention as recited in claim 1 by suggesting transmitting an incoming call notification only if the mobile station is fully engaged. See *Lewis*, paragraphs [0010], [0031]. The claimed invention, on the other hand, recites forwarding data to the general-purpose computer, “without regard to the call state of the mobile device.” Since *Lewis* teaches away from the claimed invention as recited in the amended claims, *Lewis* is an improper reference under both §102 and §103. It is respectfully requested that *Lewis* be withdrawn as a prior art reference.

For the above reasons, it is respectfully submitted that claim 1 is in condition for allowance. Claims 3-9 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Amended claim 20 substantially incorporates the elements of claim 1; therefore, claims 13-19 depending from claim 11 should also be in condition for allowance.

§103 Rejection(s):

Claims 4, 15, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lewis* in view of U.S. Patent No. 6,965,917 to Aloni et al. (hereafter *Aloni*). This rejection is respectfully traversed.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Since *Lewis* directly teaches away from the claimed invention as recited in claim 1, it is respectfully submitted that there would be no reason or motivation for a person of ordinary skill to combine *Lewis* with *Aloni*. Therefore, for the above reason alone, the §103 ground of rejection should be withdrawn. Even if *Lewis* could be combined with *Aloni*, *Aloni* still fails to cure the deficiencies of *Lewis*.

Aloni discloses a method and system for notifying a subscriber of the occurrence of an event. For example, if an e-mail message is received in the mailbox of a subscriber, a certain module then prepares a notification request for transmission to a notification server. The server parses the notification request and notifies the subscriber that an email message is received. See *Aloni*, Abstract.

Aloni, however, fails to cure the deficiencies of *Lewis*, as *Aloni* fails to teach or suggest “determining whether the first data belongs to one or more predetermined categories of data to be forwarded to the general-purpose computer; generating second data from the first data, in response to determining that the second data is needed to cause the general-purpose computer to execute one or more second telephony events equivalent or similar to the one or more first telephony events; and forwarding the first data or second data to the general-purpose computer, without regard to the call state of the mobile device, in response to determining that the first data belongs to the one or more predetermined categories, wherein the general-purpose receives the first or second data and executes the one or more second telephony events, allowing a user to access or respond to the one or more second telephony events using additional resources not available on the mobile device,” as recited in claim 1.

The Examiner is requested to point out those sections of *Aloni* that teach or suggest the above-noted elements with more specificity. While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 grounds of rejection be withdrawn.

1 *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

2 "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

For the above reasons, *Lewis*, either alone or in combination with *Aloni*, does not teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 3-9 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 20 substantially incorporates the elements of claim 1; therefore, claims 13-19 depending from claim 11 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789-2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

/F. Jason Far-hadian/

Date: May 9, 2008

By: _____
F. Jason Far-hadian, Esq.
Registration No. 42,523